

ESTTA Tracking number: **ESTTA524615**

Filing date: **03/04/2013**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Discover Financial Services
Granted to Date of previous extension	03/03/2013
Address	2500 Lake Cook Road Riverwoods, IL 60015 UNITED STATES
Attorney information	Maya L. Tarr Cowan, Liebowitz & Latman, P.C. 1133 Avenue of the Americas New York, NY 10036-6799 UNITED STATES ame@cll.com, mxt@cll.com, dks@cll.com, fxm@cll.com, trademark@cll.com Phone:212-790-9200

Applicant Information

Application No	85625491	Publication date	09/04/2012
Opposition Filing Date	03/04/2013	Opposition Period Ends	03/03/2013
Applicant	BioMed Realty Trust, Inc. 17190 Bernardo Center Drive San Diego, CA 92128 UNITED STATES		

Goods/Services Affected by Opposition

Class 036. All goods and services in the class are opposed, namely: real estate acquisition, leasing, and management services; real estate investment services; real estate investment trust services
Class 037. All goods and services in the class are opposed, namely: real estate development

Grounds for Opposition

Other	See attached pleading.
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Attachments	DISCOVER HERE NOO.pdf (4 pages)(13850 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address

record by First Class Mail on this date.

Signature	/Maya L. Tarr/
Name	Maya L. Tarr
Date	03/04/2013

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re Application Serial No. 85/625,491
Filed: May 15, 2012
For Mark: DISCOVER HERE
Published in the Official Gazette: September 4, 2012

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DISCOVER FINANCIAL SERVICES,	:	Opposition No.
	:	
Opposer,	:	
	:	
v.	:	<u>NOTICE OF OPPOSITION</u>
	:	
BIOMED REALTY TRUST, INC.	:	
Applicant.	:	
-----X	:	

Opposer, Discover Financial Services (“Discover”), a Delaware corporation, with offices at 2500 Lake Cook Road, Riverwoods, Illinois 60015, believes that it will be damaged by registration of the mark DISCOVER HERE (“Applicant’s Mark”) for “real estate acquisition, leasing, and management services; real estate investment services; real estate investment trust services” in International Class 36 and “real estate development” in International Class 37, as shown in Application Serial No. 85/625,491 (the “Application”), and hereby opposes the same.

As grounds for opposition, it is alleged that:

1. Since prior to May 15, 2012, the filing date of Applicant’s intent to use application, Discover, its affiliated and related entities and/or predecessors (collectively referred to hereinafter as “Opposer”) have used the mark DISCOVER, alone or with other word, letter and/or design elements (the “Opposer’s Marks”), in connection with the offering and sale of a wide variety of goods and the offering and performance of a wide variety of services, including, but not limited to mortgage lending, consumer lending, credit and loan services, providing

personal loans and lines of credit, banking services, debit card services, credit card services, bill payment services, electronic payment processing services, and electronic funds transfer services and related goods and services.

2. Opposer owns U.S. federal applications and registrations for Opposer's Marks including Registration Nos. 4,211,365, 4,280,808, 3,760,567, 3,458,878, 3,047,967, 3,025,822, 3,047,936, 2,805,445, 2,658,527, 2,501,064, 3,090,532, 1,746,063, 1,714,156, 1,620,369, 1,479,946, 3,747,995, 2,650,662, 2,600,964, 2,723,364, 2,660,769, 2,650,550, 2,743,341, and 1,860,749, and Application Nos. 85/571,675 and 85/790,715. Registration Nos. 3,047,967, 3,025,822, 3,047,936, 2,805,445, 2,501,064, 3,090,532, 1,746,063, 1,714,156, 1,620,369, 1,479,946, 2,650,662, 2,600,964, 2,723,364, 2,660,769, 2,650,550, 2,743,341, and 1,860,749 are incontestable.

3. Since prior to May 15, 2012, the filing date of Applicant's intent to use application, Opposer has promoted and advertised the sale and distribution of such services and goods bearing or offered in connection with Opposer's Marks, and have rendered such services and offered such goods in commerce.

4. As a result of the sales and promotion of such services and goods bearing or offered in connection with Opposer's Marks, Opposer has built up highly valuable goodwill in Opposer's Marks, and said goodwill has become closely and uniquely identified and associated with Opposer.

5. On May 15, 2012, Applicant filed the Application for Applicant's Mark for "real estate acquisition, leasing, and management services; real estate investment services; real estate investment trust services" in International Class 36 and "real estate development" in International Class 37, on an intent to use basis.

6. Upon information and belief, Applicant did not use Applicant's Mark for the goods and services covered in the Application in United States commerce prior to the filing date of its application of May 15, 2012.

7. The services covered by the Application are identical and/or closely related to the services rendered and goods offered in connection with Opposer's Marks.

8. Applicant's Mark so resembles Opposer's Marks as to be likely, when used in connection with Applicant's services, to cause confusion, to cause mistake, and to deceive the trade and public, who are likely to believe that Applicant's services have their origin with Opposer and/or that such services are approved, endorsed or sponsored by Opposer or associated in some way with Opposer. Opposer would thereby be injured by the granting to Applicant of a certificate of registration for Applicant's Mark.

WHEREFORE, Opposer believes that it will be damaged by registration of Applicant's Mark and requests that the opposition be sustained and said registration be denied. Please recognize as attorney for Opposer in this proceeding Deborah K. Squiers (member of the bar of the State of New York) and the firm Cowan, Liebowitz & Latman, P.C., 1133 Avenue of the Americas, New York, New York 10036.

Dated: New York, New York
March 4, 2013

Respectfully submitted,

COWAN LIEBOWITZ & LATMAN, P.C.
Attorneys for Opposer

By: /Maya L. Tarr/

Deborah K. Squiers

Maya L. Tarr

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CERTIFICATE OF SERVICE

I HEREBY CERTIFY that, on March 4, 2013, I caused a true and correct copy of the foregoing Notice of Opposition to be sent via First Class Mail, postage prepaid, to Applicant's Attorney of Record, Julie Dalke, Latham & Watkins LLP, 650 Town Center Dr. Ste. 2000, Costa Mesa, California 92626-7135 with a courtesy copy to John Slafsky at JSlafsky@wsgr.com.

/Maya L. Tarr/
Maya L. Tarr